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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,840	08/11/2003	Michael E. McMahan	D5407-184	4440
25397	7590	02/25/2005	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY Suite 3150 HOUSTON, TX 77027			NEUDER, WILLIAM P	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/638,840

Applicant(s)

MCMAHAN ET AL.

Examiner

William P Neuder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-18 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 5-9, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/9/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gano (6478091).

Looking at figure 6, Gano discloses providing spaced seals 88 on an expansion tool. As to claim 18, the seals are cup seals. The tubular and expansion tool are positioned in the well and the area between the seals is pressurized to cause expansion of the tubular. As to claims 2 and 3, the tool can be repositioned to expand in another area. The device is alternately pressurized and repositioned to expand the tubular.

Claims 1-4, 18, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers, Jr. et al (4069573).

Rogers discloses (figure 2) spaced seals 38 on a body of an expansion tool. As to claim 18, the seals are cup seals. The tool and tubular are positioned within the well. The area between the seals is pressurized to cause expansion of

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the tubular. As to claims 2 and 3, the tool is pressurized and then repositioned in an alternative manner to expand the tubular along its entire length. As to claims 4 and 22, figure 3 shows a swage that can be used to expand the tubular. As to claim 22, the tool and tubular are placed in the well together and are considered anchored.

Claims 1-4, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nobileau 95794702).

Nobileau discloses (figure 8b) a method of expanding tubulars. Spaced seals 33 are provided on the body of the expansion tool. As to claim 18, the seals are cup seals. The tool is positioned in the well and the area between the seals is pressurized to cause expansion of the tubular. As to claims 2 and 3, the tool is pressurized and then repositioned in alternative fashion to expand the desired length of tubular. As to claims 4 and 22, figure 8a shows a swage that also can be used to expand the tubular. As to claim 21, the tool is run with the tubular to be expanded and is considered anchored.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, Jr. et al.

It would have been considered obvious to provide at least two tools to do the expansion since the use of multiple tools would decrease the amount of repositioning of the tool. As to claim 24, the tool is anchored at its ends.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, Jr. et al in view of Teague et al (2812025).

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Rogers does not disclose the use of anchoring means on the tubular to be expanded. Teague teaches the use of anchoring means 22 on the tubular to be expanded so the expanded tubular better grips the casing or well wall. It would have been obvious to provide Rogers with anchoring means 22 as taught by Teague for the purpose of ensuring that the tubular is less likely to slip once expanded.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nobileau in view of Teague et al.

Nobileau does not disclose the use of anchoring means on the tubular to be expanded. Teague teaches the use of anchoring means 22 on the tubular to be expanded so the expanded tubular better grips the casing or well wall. It would have been obvious to provide Nobileau with anchoring means 22 as taught by Teague for the purpose of ensuring that the tubular is less likely to slip once expanded.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobileau in view of Miller (3712115).

Nobileau does not disclose repositioning of the tool by flexing the cup seals. Miller teaches repositioning of a tool by flexing the cup seals 15. It would have been considered obvious to reposition the tool of Nobileau by flexing the cup seals as taught by Miller since flexing of the cup seals is one manner to reposition the tool that is quick and easy. As to claim 14, means 16 is considered a thimble and the thimble 16 is moved to flex the cup seal.

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***Allowable Subject Matter***

Claims 5-9,19 AND 20 ARE objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P Neuder whose telephone number is 703-308-2150. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William P Neuder  
Primary Examiner  
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